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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,194	11/21/2003	Daniel Jacoff		2984

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WILLIAM COLLARD
COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

EXAMINER	
VERBITSKY, GAIL KAPLAN	

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/719,194	JACOFF, DANIEL	
	Examiner	Art Unit	
	Gail Verbitsky	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04/29/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright (U.S. 5003699) in view of Ours (U.S. 5595518).

Wright discloses in Fig. 1 a device in the field of applicant's endeavor, the device comprising an inner cavity having a curved surface of an inner wall 30, a straight cylindrical outer wall 16. Wright discloses an orienting means, keys, extending as an integral with the outer wall from an open end and extending in an opposite direction to each other. The keys have an edge and a wall. The apex of the curved surface is formed closer to the outer wall than to the ends of the inner cavity. Planes tangent to opposed spaced sides meet at 90 degrees at the apex. Planes tangent to the sides of the cavity are parallel to each other and at 90-degree angles to the plane tangent to the apex. One end of the cavity is formed by termination (closed end) 26. The open end of the device is closed with a cap. The device being manufactured by using an injection molding method. Wright does not explicitly teach that both, curved and straight cylindrical outer surfaces/ walls are formed simultaneously, as stated in claim 35.

Ours teaches that by using an injection molding method, it is possible that all the surfaces of an article be made simultaneously by injecting a material in a single step into a prepared mold.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of forming the device, disclosed by Wright, so as to use a one step, simultaneous injection molding, as taught by Ours, for simultaneously making inner and outer surfaces of the device, so as to minimize the time and costs of the manufacturing process by eliminating unnecessary steps.

The method steps will be met during the normal manufacturing process of the device stated above.

3. Claims 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright and Ours as applied to claim 35 above, and further in view of SE 148436, Johansson [hereinafter SE].

Wright and Ours disclose the device and method as stated above in paragraph 2.

They do not teach that the inner cavity has a uniform cross-section along the length, as stated in claims 36 and 38, and the remaining limitations of claims 36-42.

SE discloses in Figs. 1-3 a device comprising a straight cylindrical outer wall, a curved inner cavity having a substantially uniform arc in a cross section throughout its length, the arc having an apex 5, the apex is closer to the

cylindrical outer wall than to the opposed wall of the inner cavity. SE also discloses a cup, opposed ends spaced from the apex 5. At least one end of the cavity terminates in a wall tangents to opposed sides that meet at 90 degrees at the apex 5, as shown in Fig. 3. The planes tangent to the sides of the cavity are parallel to each other and at 90 degrees angles to the plane tangent to the apex 5, as shown in Fig. 3.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Wright, so as to have the inner cavity with a uniform cross section along the length, as taught by SE, because the court has held that a change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape (and, thus, cross section) claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. *In re Dailey, 149 USPQ 47 (CCPA 1976).*

The method steps will be met during the normal manufacturing process of the device stated above.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 35-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6735880. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of the patent includes all the limitations of claims 35-42 of the instant application.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky
Primary Patent Examiner, TC 2800

August 26, 2004